

IV. REMARKS

Claims 1-27 are pending in this application. By this amendment, claims 1, 10 and 19 have been amended. Applicant is not conceding in this application that those claims are not patentable over the art cited by the Office, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the specification is objected to. Claims 1-27 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 10-18 are rejected under 35 U.S.C. §101, as allegedly being directed to non-statutory subject matter. Claims 1-6, 8, 10-15, 17, 19-24 and 26 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Schwabe (U.S. Patent No. 6,986,132), hereafter “Schwabe,” in view of Judge *et al.* (U.S. Patent No. 6,430,564), hereafter “Judge.” Claims 7, 9, 16, 18, 25 and 27 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Schwabe in view of Judge and further in view of Connelly *et al.* (U.S. Patent No. 6,385,722), hereafter “Connelly.”

A. OBJECTIONS TO THE SPECIFICATION

The Office has asserted that the Abstract and Specification contain various deficiencies. Applicant has amended the paragraphs indicated by the Office to capitalize the term “JAR” Accordingly, Applicant respectfully requests that the rejection of the Office be withdrawn.

B. REJECTION OF CLAIM 15 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-27 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office objects to use of the word “JAVA” in the claims. Applicant respectfully submits that “...The presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. §112, second paragraph...” MPEP 2173.05(u). To this extent, the MPEP does not strictly forbid the use of trademarks in the claims, but rather only those which are not “...sufficiently precise and definite.” MPEP §608.01(v). Applicant asserts that in the word JAVA, in the context of the claimed invention, refers to an environment within which the invention functions and/or a framework that defines the structure of the constructs of the invention, and not simply a source of goods. To this extent, the term JAVA has a definite meaning, and its use in the claims is permitted. Accordingly, Applicant requests that the rejection be withdrawn.

C. REJECTION OF CLAIMS 10-18 UNDER 35 U.S.C. §101

The Office has rejected claims 10-18 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the claimed invention lacks the necessary physical components to constitute a machine or manufacture under §101. In the interest of expedited

prosecution, Applicant has amended claim 10 to include a computer device. Accordingly, Applicant requests that the rejection be withdrawn.

D. REJECTION OF CLAIMS §103(a)

With regard to the 35 U.S.C. §103(a) rejections over Schwabe in view of Judge, Applicant asserts that the references cited by the Office do not teach or suggest each and every feature of the claimed invention. For example, with respect to newly amended independent claims 1, 10 and 19, Applicant submits that the cited references fail to teach or suggest comparing the loaded classes to identify APIs that have been modified between the first release of Java byte code and the second release of the Java byte code, wherein an API has not been modified in case that it maintains a same name, parameter order, parameter types and return types in both the first release of the Java byte code and the second release of the Java byte code. Instead, in the passage of Schwabe cited by the Office, it is the API definition files that are compared and not loaded classes. Rather, as stated elsewhere herein, Schwabe teaches against comparing of loaded classes, but only compares the definition files. Furthermore, neither of the references teaches or suggests the exact comparison of the claimed invention. Accordingly, Applicant requests that the rejection be withdrawn.

With further respect to independent claims 1, 10 and 19, Applicant continues to submit that the cited references fail to teach or suggest finding matching class names between the first list and the second list, and loading classes corresponding to the matching class names. Rather, the passages in Schwabe refer to different functions of Schwabe that are completely unrelated. The first passage of Schwabe cited by the Office mentions comparing the set of classes and

interfaces in an old API definition file with those in a new API definition file. The second passage references loading of class files. However, the passages in Schwabe cited by the Office do not disclose that the loading of the class files that are loaded are of class files that are derived from the matching. In fact, Schwabe does not even indicate that the class files that are loaded are taken from its API definition files. Rather, Schwabe expressly teaches that

...verification does not continue beyond an API definition file. This differs from typical verification methods that continue the verification process into an implementation of the API definition file. Col. 14, lines 10-13.

To this extent, Schwabe teaches against the loading of classes based on results from an API definition file verification in its verification process. This is in contrast to the claimed invention in which the classes that are loaded correspond to the matching class names between the first list and the second list. For the above reasons, the separate comparing and loading of Schwabe does not teach or suggest the loading based on the matching of the claimed invention. Judge does not cure this deficiency. Accordingly, Applicant requests that the rejection be withdrawn.

With respect to dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

V. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

/Hunter E. Webb/

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